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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,836	01/05/2004	Richard Soucy	86196-36	2505
7590 SMART & BIGGAR Suite 3400 1000 de la Gauchetiere Street West Montreal, QC H3B 4W5 CANADA			EXAMINER NGUYEN, CUONG H	
			ART UNIT 3661	PAPER NUMBER
			MAIL DATE 02/18/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/750,836

**Applicant(s)**

SOUCY, RICHARD

**Examiner**

CUONG H. NGUYEN

**Art Unit**

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 15, 16 and 33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 15-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

1. This Office Action is the answer for a communication filed on 10/07/2008.
2. Claims 1-40 are pending in this application, wherein claims 1-14 were withdrawn.

*Response*

3. In a claims 15, is directed to a system for controlling speeds of a turbine engine (i.e., this broad subject matter is not necessary related to a claimed subject matter of “a rail vehicle” as amended in claim 16).

Since different search strategies must be done to completely cover all claimed subject matters (for a method comprising steps, for a rail vehicle, and for a general system having physical components) the examiner submits that restrictions are proper.

The examiner is regret for any delay this may cause.

*Claim Rejections - 35 USC 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 15 is rejected based on lacking an antecedent basis for “the power requirement” in claim 15, line 4, since a power requirement is not defined yet.

Independent claims 16, and 33 are rejected on 35 USC 112, 2<sup>nd</sup> para. since there is no limitation in these claims (limitation(s) must be explicitly required for each claim).

The examiner assumes claims 16, and 33 are independent claims; therefore, these claims must have their limitations in claims’ bodies.

*Election/Restriction*

5. Restriction to one of the following inventions is also required under 35 U.S.C. § 121 in addition to method claims:

I. Claims 16, and 33-37, are drawn to a physical system for controlling speeds of a turbine engine powering “a rail vehicle”), (claimed language explicitly show that claims 16, and 33, are drawn to a rail vehicle having a turbine engine), classified in US class 701, subclasses 19-20.

II. Claims 15, 17-32, and 38-40 are drawn to a physical system for controlling speeds of a turbine engine having a primary electric load (not necessary related to a subject matter of “a rail vehicle”), classified in US class 60/239.

6. The inventions are distinct, each from the other because of the following reasons:

Group I and group II clearly disclose different species (as shown by claim’s language), they are distinct (by different fields of applications) and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143)

Applicants are required under 35 U.S.C. 121 to elect a specific group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be

allowable – according to the pending claimed language, no generic claim is seen to be patentable.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

/CUONG H. NGUYEN/  
Primary Examiner

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